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OFFICE OF PETITIONS

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In re Patent No. 6,855,296
Issue Date: February 15, 2005
Application No. 09/831,552
Filed: September 10, 2001
Attorney Docket No.

ON PETITION

This is a decision on the petition under 37 CFR 1.378(b), filed May 29, 2009, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, the Director will undertake no further reconsideration or review of the matter.

The above identified patent issued on February 15, 2005. The first maintenance fee could have been timely paid during the period from February 15, 2008 through August 11, 2008, or with a late payment surcharge during the period from August 12, 2008 through February 15, 2009. Petitioner files a petition to accept the unintentionally delayed payment of the maintenance fee on April 13, 2009. The petition was dismissed on May 8, 2009. Petitioner now submits a petition to accept unavoidably delayed payment of maintenance fee.

Petitioner indicates that on February 6, 2007, the assignee (Optime Therapeutics) filed for bankruptcy in the United States Bankruptcy Court, Northern District of California, resulting in all assets being frozen. After petitioner filed a motion in bankruptcy court to get access to the files, the motion was granted on March 31, 2009. Petitioner now submits a petition under 37 CFR 1.378(b).

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

“A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.”

37 CFR 1.378(b)(C), requires a showing that the delay in paying the maintenance fee was unavoidable despite reasonable care being taken to ensure that the maintenance fee would be timely paid. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires *a statement by all persons with direct knowledge of the cause of the delay*, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c) (1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. *See Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988), *aff’d sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff’d*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). *See* MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a

reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee does not constitute unavoidable delay. *See Patent No. 4,409,763, supra. See also* Final Rule entitled “*Final Rules for Patent Maintenance Fees*,” published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

The renewed petition indicates that because of the assignee being in bankruptcy court all assets were frozen and he could not access these funds to pay the maintenance fees. A review of the records indicates that on September 10, 2001, inventors Martin T. Baker and William A. Heriot made an assignment of the instant invention to Optime Therapeutics, Inc. Subsequently, and prior to the issuance of the patent Optime Therapeutics, Inc., made an assignment to William A. Heriot. Hence, at the time the maintenance fees were due, Optime Therapeutics Inc., had no interest in the issued patent. In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonable prudent person. It is incumbent upon the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. The record currently lacks a showing that any steps were put in place by petitioner or anyone else.

As an alternative venue, petitioner should consider a renewed petition under 37 CFR 1.378(c), signed by both inventors accompanied by a request for reconsideration fee under 37 CFR 1.378(e), and the required fee under 37 CFR 1.120(i)(2). The current fees are \$400.00 and \$1640.00 respectively.

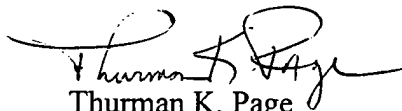
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